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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,643	10/20/2003	Tetsuya Mino	100186-00020	8971
7590	03/15/2006		EXAMINER	
AREN'T FOX KINTNER PLOTKIN & KAHN, PLLC Suite 600 1050 Connecticut Avenue, N.W. Washington, DC 20036-5339			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/687,643	MINO, TETSUYA
	Examiner Paul D. Kim	Art Unit 3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 February 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/19/05</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

This office action is a response to the amendment filed on 2/13/2006.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "a method for manufacturing a thin film magnetic head in a wafer fabricating process" as recited in lines 1-2 of claim 1 was not described in the specification as originally filed and appears to be new matter.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole et al. (US PAT. 5,452,164) in view of Okai et al. (US APT. 5,687,045).

Cole et al. teach a process of making a thin film magnetic head comprising process of: sequentially depositing a first magnetic layer (84), a non-magnetic layer (G) and a second magnetic layer (82) as shown in Figs. 7B-10; and forming a three-layer pole tip structure located between an air bearing surface and a position at a predetermined height from the air bearing surface by dry etching with ion milling (col. 10, lines 26-32) the first magnetic layer, the non-magnetic layer and the second magnetic layer at the same time as shown in Fig. 17 (col. 8, line 59 to col. 10, line 32). In addition to the Cole et al. teach an etching process by using any dry etching process such as reactive ion milling etching as well as ion beam milling (which is not the reactive ion milling disclosed in col. 10, lines 26-32).

However, Cole et al. fail to teach a material used for the non-magnetic layer, which having an etching rate equal or higher than the magnetic layers. Okai et al. teach a process of making a thin film magnetic head having an insulating layer made of metal oxide such as of silicon dioxide and tantalum oxide (as per claim 2, col. 11, lines 56-60), which has an etching rate equal or higher than the magnetic layers such as NiFe (as per claim 4) in order to decrease the etching rate of the insulating layer. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a non-magnetic layer of Cole et al. by an insulating layer made of metal oxide such as of silicon dioxide and tantalum oxide as taught by Okai et al. in order to decrease the etching rate of the insulating layer.

In addition, Cole et al., modified by Okai et al., fail to disclose a material used for the first and second magnetic layers such as nitride containing iron (FeN). Even though Okai et al. teach a material, such as NiFe, used for the magnetic layers, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use the magnetic material as recited in the claimed invention because Applicant has not disclosed that the magnetic material as recited in the claimed invention provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Okai et al. because the magnetic material of FeN as recited in the claimed invention would perform equally well with NiFe of Okai et al. because both FeN and NiFe have a high saturation magnetic flux density to be used for making the thin film magnetic head. Therefore, it would have been an obvious matter of design choice to modify the magnetic material of Okai et al. to obtain the invention as specified in claim 3.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground of rejection. Rejections are based on the newly cited reference.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729